REMARKS/ARGUMENTS

Status of the Claims.

Claims 20-33 are pending in the application, claims 31-33 being added herein. Claims 31-33 find support at least in the previously pending claims (*see* claims 20, 23, and 27).

Election/Restriction Requirement.

In the Office Action the Examiner identified twelve Claim Groups and required election of one of the Claim Groups for prosecution in the present application. Office Action, pages 2-3. The twelve Claim Groups were identified by the Examiner as follows:

I. Claims 20-22, "drawn to a method of treating diabetes with P- and A-type inositolphosphoglycans (IPG);"

II. Claims 20-22, "drawn to a method of treating diabetes with a P-type IPG;"

III. Claims 20-22, "drawn to a method of treating diabetes with an A-type IPG antagonist;"

IV. Claims 23-24, "drawn to a method of treating obese type II diabetes with a P-type IPG;"

V. Claims 23-24, "drawn to a method of treating obese type II diabetes with an antagonist of an A-type IPG;"

VI. Claims 23-24, "drawn to a method of treating obese type II diabetes with both a P-type IPG and an A-type IPG antagonist;"

VII. Claims 25-26, "drawn to a method of treating type I diabetes with a P-type IPG and an A-type IPG;"

VIII. Claims 25-26, "drawn to a method of treating lean type II diabetes with a P-type IPG and an A-type IPG;"

IX. Claims 27-28, "drawn to a composition of a P-type IPG;"

X. Claims 27-28, "drawn to a composition of an antagonist of an A-type IPG;"

XI. Claims 27-28, "drawn to a composition of a P-type IPG and an antagonist of an A-type IPG;" and

XII. Claims 29-30, "drawn to a composition of a P- and an A-type IPG.

Applicants elect Claim Group V (claims 23 and 24, insofar as they relate to a method of treating obese type II diabetes with an antagonist of an A-type IPG) with traverse.

A proper restriction must satisfy two requirements. First, the restricted Claim Groups must define independent or distinct subject matter. Second, the examination of the restricted Claim Groups in a single application must represent a serious burden to the Examiner. Applicants respectfully submit that the Office Action fails to provide a rationale for the second requirement that justifies a 12-way restriction. In this regard, the Office Action states only that "Groups I-XII are distinct because prior art searches required for Groups I-XII are not necessarily of overlapping scope." Office Action, page 4. Applicants note that, if a sufficiently broad search were done (*e.g.*, a search of the use of IPG-based therapeutics to treat diabetes), this statement is simply not true. Applicants submit that the fact that it is possible to design narrow searches of the claimed subject matter that would exclude certain elements of the invention cannot be used to establish serious burden justifying restriction.

The Office Action suggests that 12 separate searches must be conducted to fully search the claimed subject matter (hence the 12-way restriction). Yet many of the Claim Groups were classified in the same class and subgroup. Indeed, according to the Office Action, the claimed subject matter fell into only three different classifications. This fact further supports Applicants' position that the 12-way restriction is improper.

In an attempt to buttress his rationale, the Examiner cites a specific example of non-co-extensive searching, noting that "methods of treatment using a composition consisting of a P-type IPG and an A-type IPG need not read as prior art on a method of treatment using only [a] P-type IPG or only an A-type IPG." *Id.* This rationale overlooks the fact, however, that a search for art relating to methods of using a P-type IPG to treat diabetes would necessarily encompass art relating to methods of using a P-type IPG in combination with an A-type IPG.

Applicants respectfully point out that a search for art relating to methods of using an antagonist of an A-type IPG to treat diabetes (Claim Group III) would necessarily encompass art relating to methods of using such an agent to treat obese type II diabetes (elected Claim Group V). In addition, such a search would also encompass art relating to methods of using an A-type IPG antagonist in combination with a P-type IPG (claims 31 and 32). Accordingly, even if the Examiner's position is accepted as correct (which Applicants do not concede), Claim Groups III and V, as well as claims 31 and 32, should be examined together in the present application, at least

insofar as they relate to the use of an A-type IPG antagonist (alone or in combination) to treat any form of diabetes. In this regard, Applicants note that Claim Groups III and V both classified in class 425, subclass 130.1, further supporting Applicants' position. Therefore, if the Examiner does not withdraw the restriction requirement in its entirety, Applicants respectfully request that Claim Groups III and V be rejoined and examined with new claims 31 and 32.

Turning to the restriction between the method claims and product claims, Applicants submit that this restriction is at least partially improper for failure to establish that all of the Claim Groups define distinct inventions. (Note that Applicants' position should not be misconstrued as an admission that any of the Claim Groups is/are not patentably distinct.) More specifically, the Examiner contends that restriction between the method claims and product claims is proper because "the compositions of Groups IX-XII could be used in methods of detecting the presence of type I diabetes, lean type I diabetes and obese type II diabetes, rather then in the claimed methods of treating these diseases in Groups I-VIII." Office Action, page 3. Yet this rationale does not apply to restriction between Claim Groups V and X. Claim Group X relates to an antagonist of an A-type IPG. It is unclear how a generic A-type IPG antagonist, which need not bind to A-type IPGs (*see* Applicants' specification, page 13, lines 16-25), would be used in a diagnostic method for type I diabetes, lean type II diabetes, or obese type II diabetes. Accordingly, for this additional reason, the Office Action fails to establish that restriction between Claim Groups V and X is proper. The Examiner must therefore either provide a proper justification for this restriction or withdraw it.

In summary, Applicants respectfully withdrawal of the restriction requirement in its entirety. Short of this, Applicants request that Claim Groups III, V, and X be examined in the present application, together with new claims 31-33. New claim 33 relates to a composition comprising an antagonist of an A-type IPG in combination with a P-type IPG. As explained above with respect to the method claims, a search of Claim Group X would cover all compositions containing A-type IPG antagonists, alone or in combination with anything else. Thus, a search of Claim Group X would encompass the subject matter of claim 33. Because Claim Groups III, V, and X and claims 31-33 can be examined together in the present application without serious burden, such examination is proper.

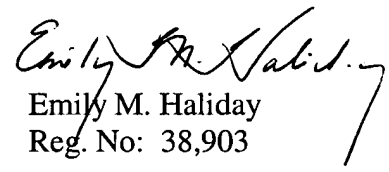
Conclusion

In view of the foregoing, Applicants believe that all claims now pending in this application can be examined herein without serious burden. Such examination is respectfully requested.

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (510) 769-3509.

QUINE INTELLECTUAL PROPERTY LAW GROUP, P.C.
P.O. BOX 458
Alameda, CA 94501
Tel: 510 337-7871
Fax: 510 337-7877

Respectfully submitted,



Emily M. Haliday
Reg. No: 38,903